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| <b>TRANSMITTAL FORM</b><br>(to be used for all correspondence after initial filing) |    | Application Number     | 09/653224        |
|   |    | Filing Date            | Aug 31, 2000     |
|   |    | First Named Inventor   | Mayes, Robert C. |
|   |    | Art Unit               | 3629             |
|   |    | Examiner Name          | Tan D. Nguyen    |
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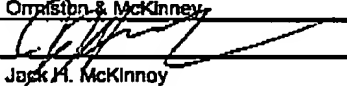
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| Remarks<br>Attached is a resubmitted substitute Brief as required in response to the Patent Office's communication mailed August 24, 2005. No fee required.   |  |   |

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

|              |   |          |       |
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| Firm Name    | Ormiston & McKinney   |          |       |
| Signature    |  |          |       |
| Printed name | Jack H. McKinney  |          |       |
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IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Robert C. Mayes GROUP ART UNIT: 3629

SERIAL NO.: 09/653,224

EXAMINER: Tan D Nguyen

FILED: 8/31/2000

SUBJECT: TAILORED METHOD AND SYSTEM FOR CUSTOM  
MANUFACTURED BOOKS

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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**3. STATUS OF CLAIMS.**

Claims 1 and 4-15 are pending and stand rejected. Claims 2, 3, and 16-21 were previously cancelled. All pending claims are appealed.

**4. STATUS OF AMENDMENTS.**

No amendments have been filed after the final action was been entered. All previous amendments have been entered.

**5. SUMMARY OF CLAIMED SUBJECT MATTER.**

Claim 1 recites a book manufacturing method that includes receiving a dimension of a book storage space and selecting format criteria and page and cover media according to both the received dimension and an identified set of books. The format criteria define at least a font size. The selections are made so that the set of books, once manufactured, will fit within the book storage space. *See, e.g.,* Specification, page 5, lines 12 through page 7, line 8. Claims 4-6 depend from Claim 1.

Claim 7 recites a book on demand system and includes an order placement system capable of receiving input identifying a set of books and a dimension of a book storage space. The order placement system is also responsible for selecting format criteria according to both the received dimension and the identified set of books. The format criteria define at least a font size. The selection is made so that the set of books, once manufactured, will fit within the book storage space. *See, e.g.,* Specification, page 5, lines 12 through page 7, line 8. Claims 9-11 depend from Claim 7.

Claim 12 recites a computer readable medium that includes instructions for receiving a dimension of a book storage space and for selecting format criteria and page and cover media according to both the received dimension and an identified set of books. The format criteria define at least a font size. The selections are made so that the set of books, once manufactured, will fit within the book storage space. *See, e.g.,* Specification, page 5, lines 12 through page 7, line 8. Claims 13-15 depend from Claim 12.

**6. GROUNDS FOR REJECTION TO BE REVIEWED.**

A. A prima facie case for obviousness has not been established in that neither Garrido (USPN 6,012,890) nor Burton (USPN 4,589,376), alone or in combination, teach or suggest receiving a dimension of a book storage space and selecting format criteria and page and cover media according to the received dimension so that a set of books, once manufactured, will fit within the book storage space.

B. A prima facie case for obvious has not been established in that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Garrido (USPN 6,012,890) or Burton (USPN 4,589,376) or to combine reference teachings.

**7. ARGUMENT.**

A. **Ground For Rejection A (Claims 1 and 4-15) – Garrido and Burton, alone or in combination, fail to teach or suggest receiving a dimension of a book storage space and selecting format criteria and page and cover media according to the received dimension so that a set of books, once manufactured, will fit within the book storage space.**

Claims 1 and 4-15 were rejected under 35 U.S.C. § 103 as being unpatentable over Garrido (USPN 6,012,890) in view of Burton (USPN 4,589,376). To establish a prima facie case of obviousness, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; that there is a reasonable expectation of success; and that *the prior art reference (or references when combined) teach or suggest all the claim limitations*. MPEP § 2142.

Garrido is directed to a method and system for producing books on demand and discusses producing books in four sizes – those sizes being dictated by the sizes of commercially available sheets of paper. Garrido, abstract and Col. 7, lines 29-46. The user selects the paper size, and the user selects size and type fonts to be used for the purpose of assisting a sight challenged reader. Col. 7, lines 23-28 and 47-49. Garrido places no restriction on the font size or paper size the user can select. Garrido makes no mention of receiving measurements of a book storage space,

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selecting format criteria that includes a font size, or producing books to fit in a book storage space.

Burton teaches a custom manufacturing process where a customer's measurements are taken and transmitted to a computer where an order is generated. The order is transmitted to a remote location for manufacture. An article of clothing is then manufactured according to the customer's measurements. Burton, Abstract. In short, Burton teaches receiving a measurement of a customer (not a book storage space) and tailoring a garment according to that measurement.

Each of Claims 1, and 4-15 in some fashion (directly or indirectly) recites that a production of books be guided by a dimension of a storage space. To that end, each of the claims in some fashion requires the selection of format criteria (that defines at least a font size) and page and cover media according to the dimension of the book storage space. This is not taught or suggested by Garrido or Burton alone or in combination.

Nothing in Burton or Garrido expressly or inherently teaches selecting format criteria and page and cover media according to the received dimension and the identified set of books where the format criteria defines at least a font size. In the July 12, office action, the Examiner contends that it "would have been obvious for an artisan to select a format criteria defining font size and paper and cover media so that the book can be properly printed and sized to fit the item holder in the future after manufacturing." The Examiner continues: "selecting a font size too high or big will increase the book thickness or height which may not fit the book holder."

The Examiner's position can be based on nothing but hindsight. To create a garment that fits a particular customer, Burton teaches laser cutting of garment pieces (according to given dimensions) from a larger piece of fabric and assembling those pieces to form the garment. See, e.g., Burton, abstract. Compared to the present invention, the teachings of Burton are akin to cutting pages of a particular size from a roll of paper and binding those pages to form a blank book. That, by itself, is of no use to the reading customer. The present invention requires much more. The present invention requires that the bound pages include the text of a selected book. The purpose of the book is to be read, not worn. The application of Burton has no bearing on the selection of a font size that limits the number of pages required to manufacture

a book and allows that book to fit within a space of a particular physical dimension. There is no such similarity between Burton and the present invention.

Burton merely teaches the manufacture of a garment that fits a defined body size. Not only do Claims 1 and 4-15 in some fashion require the manufacture of a physical object that fits in a defined space, they require that the physical object contain the text of a selected book. So that these requirements can be met, format criteria that includes at least a font size, are selected so that a book of a particular physical dimension can contain the selected text and fit within the defined space.

Consequently, Garrido and Burton, alone or in combination, do not teach all the limitations of Claims 1 and 4-15. As such, the rejection of Claims 1 and 4-15 is improper as the Examiner failed to establish a prima facie case for obviousness under 35 USC §103.

**B. Ground For Rejection A (Claims 1 and 4-15) – There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Garrido (USPN 6,012,890) or Burton (USPN 4,589,376) or to combine reference teachings.**

As noted above, Claims 1 and 4-15 were rejected under 35 U.S.C. § 103 as being unpatentable over Garrido (USPN 6,012,890) in view of Burton (USPN 4,589,376). To establish a prima facie case of obviousness under 35 USC §103, the Examiner must show *some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings*; that there is a reasonable expectation of success; and that the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2142. There is

Garrido is directed to a method and system for producing books on demand and discusses producing books in four sizes – those sizes being dictated by the sizes of commercially available sheets of paper. Garrido, abstract and Col. 7, lines 29-46. Burton teaches a custom manufacturing process where a customer's measurements are taken and transmitted to a computer where an order is generated. The order is transmitted to a remote location for manufacture. An article of clothing is then manufactured according to the customer's measurements. Burton, Abstract.

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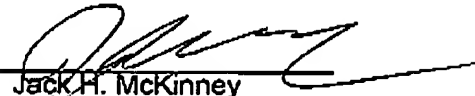
The Examiner admits that Garrido fails to teach the selection of format criteria according to a dimension of a book storage space where the format criteria includes at least a font size so that a manufactured book will fit in the book storage space. Instead, the Examiner contends that Burton teaches a method and apparatus "to produce items that will fit the item holder." Office Action, July 12, page 4, lines 7-11.

The Examiner has not shown any suggestion or motivation in Garrido or in Burton to modify those references or to combine their teachings. Instead, the Examiner mysteriously contends that it "would have been obvious for an artisan to select a format criteria defining font size and paper and cover media so that the book can be properly printed and sized to fit the item holder in the future after manufacturing." Office Action, July 12, page 5, lines 3-5.

The teachings of Burton are not relevant to the particular problems addressed by the present invention and by Garrido. Burton teaches the manufacturing of a garment according to the dimensions of an individual. The teachings of Burton, however, have nothing to do with the manufacturing of a garment according to the dimensions of a storage space let alone manufacturing a book to fit within the confines of a book storage space. Burton provides no indication or motivation for such. The sole goal of Burton is to provide a garment tailored to fit around the physical dimensions of an individual. Burton is irrelevant prior art because its teachings are outside the field of and are not analogous to the present invention. See *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003). Consequently there can be no motivation found in the in the knowledge generally available to one of ordinary skill in the art to modify Burton or Garrido as apparently suggested by the Examiner.

Because, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Garrido (USPN 6,012,890) or Burton (USPN 4,589,376) or to combine their teachings, the rejection of Claims 1 and 4-15 is improper. The Examiner failed to establish a prima facie case for obviousness under 35 USC §103.

Respectfully submitted,  
Robert C. Mayes

By   
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**APPENDIX OF CLAIMS INVOLVED IN THE APPEAL**

1. A book manufacturing method, comprising:  
identifying a set of books;  
receiving a dimension of a book storage space;  
selecting format criteria and page and cover media according to the received dimension and the Identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and  
manufacturing the set of books according to the selected format criteria and using the selected page and cover media.
4. The method of claim 1, further comprising receiving payment information.
5. The method of claim 1, further comprising receiving payment information prior to manufacturing.
6. The method of claim 5, further comprising providing a purchase cost for manufacturing the set of books.
7. A book on demand system, comprising:  
an order placement system capable of receiving input identifying a set of books and a dimension of a book storage space and of selecting page and cover media as well as format criteria according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space;  
a print module operable to use selected page media and format criteria to print the pages of the set of books and to use selected cover media to print the covers of the set of books; and  
a finishing module operable to bind each printed cover and corresponding printed pages to produce a set of finished books.

8. The book on demand system of claim 7, wherein the order placement system is capable of providing the user with a purchase cost.

9. The book on demand system of claim 8, wherein the order placement system is further capable of receiving payment information and the print module is operable to only print the cover and the pages after the order placement system receives payment information.

10. The book on demand system of claim 9, further comprising an electronic database for storing the book in an electronic form.

11. The book on demand system of claim 10, wherein the print module includes at least one printer, coupled to the order placement system, for printing the pages and cover of the book.

12. Computer readable media having instructions for:  
receiving input identifying a set of books;  
receiving input defining a dimension of a book storage space;  
selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and  
directing the production of the set of books according to the selected format criteria and using selected page and cover media.

13. The media of claim 12, having further instructions for receiving payment information.

14. The media of claim 13, wherein the instructions for directing include instructions for directing only upon receipt of payment information.

15. The media of claim 14, having further instructions for providing a purchase price for the book.

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**Evidence Appendix**

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

**Related Proceedings Appendix**

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.